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10/767,780	01/28/2004	Shingo Fukui	P/1878-188	5531

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NEW YORK, NY 100368403

EXAMINER
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DARNO, PATRICK A

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/767,780

Applicant(s)

FUKUI, SHINGO

Examiner

Patrick A. Darno

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2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 12-23, and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 5-11 and 24-30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01082004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-37 are pending in this office action.

#### ***Claim Objections***

2. Claims 5-11 are objected to because the claims from which they depend are rejected. If the claims from which they depend were corrected as discussed in the following office action, claims 5-11 would be in condition for allowance.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the Examiner has not found sufficient enablement in the Applicant's specification that would enable one of ordinary skill in the art to make and use a computer program comprising the steps of "...first processing...", "...second processing...", and "...third processing..." as presented in Applicant's claim 37. As currently understood in the art, a computer program itself does not comprise "processing". A computer program may include code or instructions that when executed cause processing to occur.

In order to overcome this rejection, the Applicant must either provide the Examiner with evidence of sufficient enablement in the Applicant's specification of how a computer program itself actually comprises processing, or the Applicant must amend the claims in order to show computer program instructions which, when executed, cause the computer's processor to carry out a step of processing information.

The Examiner provides the following suggestion for overcoming this rejection. The claim limitations could read: "computer executable instructions cause a processor to perform first processing for....". This language, or similar language of this kind, needs to be added to each limitation by amendment in order to overcome the rejection given above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-17, 31-34, and 37 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 12, the claim recites "performing different processing depending on the availability condition of each of said nodes". However, there is no mention of processing in any of the parent claims. Therefore, the Examiner believes that limitation lacks antecedent basis because it suggests choosing a different form of processing when no processing has been previously discussed. Appropriate clarification and correction is required.

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With respect to claim 12, the claim recites "performing different processing", but never clarifies exactly what is being processed or how it is being processed. The Applicant does not particularly point out and distinctly claim the steps of processing involved in the claim, so the claim is rejected under 35 U.S.C. 112, second paragraph. In order to overcome this rejection, it is required that the Applicant first clarify exactly what is being processed. Once it is determined exactly what item is being processed, the claim must further clarify how it is being processed. Appropriate clarification and correction is required.

With respect to claim 13, the claim is rejected because the claim language recites "performing the one selected by the user". The phrase "the one" lacks positive antecedent basis and therefore makes the claim language unclear. It is required that the Applicant amends the claim to clarify exactly what "the one" is referring to. As a suggestion, the Examiner believes the wording "performing the processing operation selected by the user" will overcome the 35 U.S.C. 112 second paragraph rejection given by the Examiner if added by amendment to claim 13.

Claim 13 is again rejected because it inherits and contains the deficiencies of claim 12.

Claim 14 is rejected under the same reasons set forth in the rejection of claim 12.

Claim 15 is rejected under the same reasons set forth in the rejection of claim 13.

Claim 16 is rejected under the same reasons set forth in the rejection of claims 12 and 14.

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Claim 17 is rejected under the same reasons set forth in the rejection of claims 13 and 15.

Claim 31 is rejected under the same reasons set forth in the rejection of claims 12, 14, and 16.

Claim 32 is rejected under the same reasons set forth in the rejection of claims 13, 15, and 17.

Claim 33 is rejected under the same reasons set forth in the rejection of claims 12, 14, 16, and 31.

Claim 34 is rejected under the same reasons set forth in the rejection of claims 13, 15, 17, and 32.

With respect to claim 37, the Examiner believes that it is unclear to one of ordinary skill in the art how a computer program could comprise steps of "...first processing...", "...second processing...", and "...third processing". As currently understood in the art, a computer program itself does not comprise "processing". A computer program may include code or instructions that when executed cause processing to occur.

The Applicant must either explain how it is possible for a computer program to comprise "processing" or the Applicant is required to amend the claims in such a way that particularly points out and distinctly claims the Applicant's invention. The suggestion given by the Examiner to resolve the 35 U.S.C. 112, first paragraph, rejection would be sufficient to also overcome this rejection under 35 U.S.C. 112,

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second paragraph. If the corrections are made to claim 37 that were suggested above by the Examiner, this rejection of claim 37 will also be overcome.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-4 and 18-37 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter.

With respect to claim 1, the claim is again rejected under 35 U.S.C. 101 because if the condition in the first step is not satisfied, no result or conclusion step is recited in the claim language to indicate that a resultant or conclusionary step occurs. If no resultant or conclusionary step is given for the method when the condition of the first step is not satisfied, then surely no useful, concrete, and tangible result of a practical application of the invention is set forth when the condition of the first step is not satisfied. Basically, the deficiency arises because steps two and three never occur when the condition of the first step is not satisfied. In order to overcome this rejection, the Applicant must amend the claims in a manner such that there is a useful, concrete, and tangible result that occurs both when the condition of first step is satisfied, and when the condition of the first step is not satisfied.

The Examiner suggest the following amendment to claim 1 in order to overcome the given 35 U.S.C. 101 rejection: "a third step in which said computer refers...such that said condition is satisfied, upon the failure of the condition in said first step.". This

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language, or similar language of this kind, needs to be added to the claim by amendment in order to overcome the rejection given above.

Claims 2-4 and 18-19 are rejected because they either inherit or contain the deficiencies of claim 1.

With respect to claim 20, the claim recites that an apparatus. However, the claims are not actually limited to any physical articles or objects. It appears that the Applicant is seeking to patent particular programmed functionality of the components rather than the components themselves. Specifically, the claim limitations of 'execution possibility determining means', 'availability condition manipulating means', and 'tree structure manipulating means' all appear to be directed to software subroutines. Since the claim limitations are indeed directed to programmed functionality and not the components of an apparatus themselves, the claimed programmed functionality must have a final result achieved which is useful, concrete, and tangible. See the rejections given to claim one for further guidance as to the type of amendments that need to be made in order to overcome the rejection. See rejection of claim 1 for the suggestions of how to fix the claim language to comply with 35 U.S.C. 101.

Claim 20 is again rejected under the same reasons set forth in the rejection of claim 1.

Claims 21-36 are rejected because they either contain or inherit the deficiencies of claim 20.

With respect to claims 20 and 37, the claims are directed to software that is not embodied on an appropriate computer readable medium. Computer software or

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computer programs themselves constitute non-statutory subject matter. However, when a computer program is tangibly embodied on an acceptable computer readable medium, the claimed computer program can be eligible for patentability if all other criteria for patentability are in compliance. In order to overcome this rejection the applicant must amend the claims to show that computer software modules and 'information sharing program' as claimed are tangibly embodied on a computer readable medium which permits the computer program to interact with the hardware components of the computer to functionally realize the method steps set forth in the computer program.

Claim 37 is again rejected under the same reasons set forth in the rejection of claim 1. See rejection of claim 1 for the suggestions of how to fix the claim language to comply with 35 U.S.C. 101.

### ***Allowable Subject Matter***

6. Claims 1 and 20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 set forth in this Office action.

7. Claims 37 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, second paragraph, set forth in this Office action and if the rejection given under 35 U.S.C. 112, first paragraph can be overcome.

8. Furthermore, if the corrections cited above are made to independent claims 1, 20, and 37, and the if the deficiencies of dependent claims 2-4, 17-19, 21-23, and 31-

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36, which are clearly stated in the above office action, are corrected, then claims 1-37 would become allowable.

***Related Art***

9. The following references qualify as prior art under various subsections of 35 U.S.C. 102. The references cited below represent the best prior art that the Examiner was able to discover at the present time. However, none of the following references alone or in combination were found to include all of the limitations of the Applicant's invention as claimed. The references are:

- U.S. Patent Application Publication Number 2005/0076030 issued to Satoshi Hada et al.
- U.S. Patent Application Publication Number 2003/0061216 issued to Fred Moses.
- U.S. Patent Application Publication Number 2003/0110246 issued to Robert Byrne et al.
- U.S. Patent Number 6,026,402 issued to Joseph K. Vossen et al.
- U.S. Patent Application Publication Number 2003/0142824 issued to Tomoyuki Asano et al.

10. The following references do not qualify as prior art under various subsections of 35 U.S.C. 102. However, the Examiner believes that the references are similar enough to the Applicant's claimed invention that they should be listed on the record. While it is noted that these references are similar to the Applicant's claimed invention, it should be noted for the record that the Examiner does not believe that any of the references alone

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or in combination disclose or contain all the elements of the Applicant's invention as claimed. The references are:

- U.S. Patent Application Publication Number 2006/0112177 issued to Warren Vincent Barkley et al.
- U.S. Patent Application Publication Number 2006/0212457 issued to Jeffrey T. Pearce et al.
- U.S. Patent Application Publication Number 2006/0143179 issued to Vadim Draluk et al.
- U.S. Patent Application Publication Number 2005/0010585 issued to Mikko Sahinoja et al.
- U.S. Patent Application Publication Number 2006/0089932 issued to Dieter Buehler et al.
- U.S. Patent Application Publication Number 2005/0289150 issued to Michiharu Kudo.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

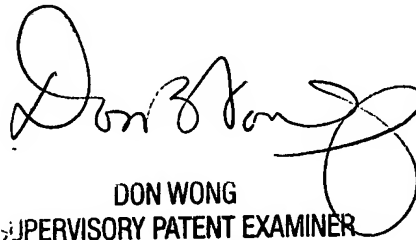
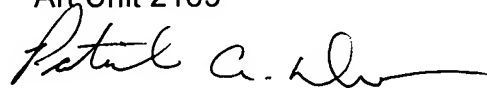
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PD

Patrick A. Darno  
Examiner  
Art Unit 2163



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